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EXAMINER

GEBRIEL, SELAM T

ART UNIT

PAPER NUMBER

2622

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DELIVERY MODE

10/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/813,723 | <b>Applicant(s)</b><br>MORRIS, ROBERT P. |  |
|                              | <b>Examiner</b><br>SELAM T. GEBRIEL  | <b>Art Unit</b><br>2622                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 43-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments and amendment filed on 07/01/2008 have been fully considered but they are not persuasive.
2. During a telephonic interview on July 1, 2008, an amendment to claims 43 and 61 as presented by the applicant were discussed with reference to the cited prior art. An agreement was reached at that moment that the amendment to claim 43 and 61 as presented likely distinguishes the claim from the cited prior art, during the interview the examiner also informed the applicant that the reference cited will be reviewed and checked carefully again. With careful reviewing and checking the examiner believes the reference cited teaches the limitation of the amended claim. See below for further explanation.
3. As for argument Anderson et al. discloses actions to be taken by a server when the images are uploaded to the server from a handheld image capture device. See the abstract of Anderson et al. The claims, as amended, require that actions be performed on a stored file in the portable image capture device. It is therefore respectfully submitted that Anderson teaches away from the features of independent claims 43 and 61 and therefore does not teach all of the features of the claims. It is therefore respectfully submitted that the rejection of claims 43 and 61 be withdrawn.

The examiner respectfully disagrees with the applicant. See Col 11, Line 32 - 67 to Col 12, Line 1 - 67 and Col 13, Line 1 - 14). Jack is able to send directly from the

camera to a photo album. Therefore the file handling actions are performed within the camera when an input event is detected on the portable image capture device.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 43 and 47 – 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson (US 7117519 B1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

6. Regarding Claim 43, Anderson discloses a method for specifying and automating file handling in a portable image capture device (Figure 1, Element 14, Col 3, Line 43 - 52), the portable image capture device including at least one stored file (Figure 1,

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Element 34) and configured to communicate with a computer (Figure 1, Element 24),  
the method comprising:

In response to a user configuring an action list (Figure 5, Element 48) on the computer (Figure 1, Element 24) by mapping one or more user input events detectable (Col 8, Line 18 – 19, User initiating image upload, the user will upload the images once there is a connection between the camera and server) on the portable image capture device to one or more file handling actions (Col 8, Line 23 – 27, sending the images to a list of email address, performing some type of analysis or calculation on the image data) on the at least one stored file (The image saved inside the camera and then uploaded to the server when there is connection between the camera and the server), downloading the action list from the computer to the portable image capture device (Col 10, Line 58 – 63 and Col 8 and Col 9, Line 1 – 12, "The action list is displayed to the user on the image capture device for user selection once a connection between the server and camera is detected"); and

Performing, on the at least one stored file included in the portable image capture device the corresponding file handling action on the at least one stored file within the portable image capture device when an input event on the portable image capture device is detected that matches one of the user input events in the action list (Col 8, Line 14 – 46 and Col 11, Line 32 - 67 to Col 12, Line 1 - 67 and Col 13, Line 1 - 14).

7. Regarding Claim 47, Anderson discloses the method of claim 43 wherein the at least one stored file comprises a digital image (Figure 1, Element 34) by the portable image capture device.

8. Regarding Claim 48, Anderson discloses the method of claim 43 wherein the computer is used to access a server via a web browser (Figure 1, Element 24, and Col 8, Line 65), the method further comprising: configuring the action list on the server in response to user input (Col 8, Line 47 – 61 and Col 7, Line 16 - 22).

9. Regarding Claim 49, Anderson discloses the method of claim 48 further comprising retrieving the user's account information (Col 7, Line 64 – 67 to Col 8, Line 1 – 6), including the device type and an operating environment of the device in response to the user logging into the server (Figure 1 Element 12).

10. Regarding Claim 50, Anderson discloses the method of claim 49 further comprising displaying to the user a list of supported user interface input events specific to the user's type of device for the user to select a desired set of input events (Col 8, Line 7 – 22, User Initiating an image upload is one input event that is specific to the user's type of device).

11. Regarding Claim 51, Anderson discloses the method of claim 50 further comprising displaying a set of actions that can be performed when each selected event occurs for the user to map one or more actions to each event (Figure 5, and Col 8, Line 23 - 46).

12. Regarding Claim 52, Anderson discloses the method of claim 51 wherein the set of actions may include any combination of e-mailing the file as an attachment, posting the file to a photo sharing service, posting the file to a specified web site, resizing if the file is an image, and saving the file to a folder (Figure 5, and Col 8, Line 23 - 46).

13. Regarding Claim 53, Anderson discloses the method of 51 further comprising storing the mappings as a downloadable action list (Col 8, Line 18 – 46).

14. Regarding Claim 54, Anderson discloses the method of claim 43 further including requesting the action list from the computer by the device (Col 7, Line 64 – 67 to Col 8, Line 22, “Once there is a connection with the server and the camera, all the action list associated with that camera will be downloaded in the camera”).

15. Regarding Claim 55, Anderson discloses the method of claim 54 further comprising:

Transmitting identity information from the device to the server for the server to use to retrieve the action list configured by the user (Col 7, Line 64 – 67 to Col 8, Line 22); and

Downloading the action list to the device (Col 7, Line 64 – 67 to Col 8, Line 22, “Once there is a connection with the server and the camera, all the action list associated with that camera will be downloaded in the camera”).



***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 44-46 and 56 – 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (US 7117519 B1) in view of Shiohara et al. (US 7,283,158).

18. Regarding Claim 44, Anderson failed to teach downloading an executable file associated with the corresponding file handling action to the portable image capture device; and executing the executable file in the device in order to perform the file handling action.

Shiohara discloses downloading an executable file (Programs for generating print image data) associated with the corresponding file handling action (Print image data) to the portable image capture device; and executing the executable file in the device in order to perform the file handling action (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35) .

Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the teaching of Anderson with Shiohara method of downloading an executable file or program associated with a corresponding file handling action. The motivation to do so is to effectively utilize the limited memory

capacity of the digital camera, it is important that programs for generating print image data each having a relatively large program size can be installed from the external device into the digital camera as occasion demands or such installed programs can also be deleted. If the program is handled in such way, different programs, for example, a direct printing program, a communication program, an image correction program, or the like, can be replaced and then employed (Col 3 Line 10 – 19).

19. Regarding Claim 45, Anderson in view of Shiohara disclose the method of claim 44 wherein downloading the executable file associated with the file handling action to be performed comprises downloading the executable file corresponding to the file handling action when the action is to be performed (Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

20. Regarding Claim 46, Anderson in view of Shiohara disclose the method of claim 44 further comprising downloading all executable files associated with the file handling actions in the action list at the time the action list is downloaded (Col 2, Line 60 – 67 to Col 3, Line 1 – 35, "Reading out the program from the recording medium in the digital medium at a desired time").

21. Regarding Claim 56, Anderson in view of Shiohara disclose the method of claim 55 wherein performing the corresponding file handling action (Print image data) includes downloading an executable file that is compatible with the device's operating environment (Shiohara, Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

22. Regarding Claim 57, Anderson in view of Shiohara disclose the method of claim 56 wherein the device sends operating environment information to the server in the request in order for the server to find the action executable file appropriate for the device's operating environment (Shiohara, Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

23. Regarding Claim 58, Anderson in view of Shiohara disclose the method of claim 43 further comprising retrieving an executable file necessary to perform the corresponding file handling action (Shiohara, Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

24. Regarding Claim 59, Anderson in view of Shiohara disclose the method of claim 58 further comprising:

Determining if the executable file is present in memory of the portable image capture device (Shiohara, Col 2, Line 60 – 67 to Col 3, Line 1 – 35); and

If the executable file is present in the memory, retrieving and executing the executable file from the memory, thereby performing the action (Shiohara, Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

25. Regarding Claim 60, Anderson in view of Shiohara disclose the method of claim 59 further comprising:

If the executable is not present in the memory of the portable image capture device: retrieving the executable file from the computer; and executing the executable file (Shiohara, Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

26. Regarding Claim 61, Anderson does not clearly disclose a computer-readable medium encoded with computer executable instructions for specifying and automating file handling in a portable image capture device, the portable image capture device including at least one stored file and configured to communicate with a computer, the instructions, when executed: downloading an action list from the computer to the portable image capture device, the action list comprising a mapping of one or more user input events on the portable image capture device to one or more file handling actions on the at least one stored file; and performing on the file, corresponding file handling action within the portable image capture device when an input event is detected on the portable image capture device that matches one of the events in the downloaded action list

However Shiohara discloses downloading an executable file (Programs for generating print image data) associated with the corresponding file handling action (Print image data) to the portable image capture device; and executing the executable file in the device in order to perform the file handling action (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35) .

Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the teaching of Anderson with Shiohara method of

downloading an executable file or program associated with a corresponding file handling action. The motivation to do so is to effectively utilize the limited memory capacity of the digital camera, it is important that programs for generating print image data each having a relatively large program size can be installed from the external device into the digital camera as occasion demands or such installed programs can also be deleted. If the program is handled in such way, different programs, for example, a direct printing program, a communication program, an image correction program, or the like, can be replaced and then employed (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35)

27. Regarding Claim 62, Anderson in view of Shiohara discloses the computer-readable medium of claim 61 further comprising providing an interface that allows a user to configure the action list (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35)

28. Regarding Claim 63, Anderson in view of Shiohara discloses the computer-readable medium of claim 61 further including instructions for downloading an executable file associated with the file handling action to be performed and executing the executable file in the device in order to perform the action (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35)

29. Regarding Claim 64, Anderson in view of Shiohara discloses the computer-readable medium of claim 63 further comprising instructions for downloading the

executable file corresponding to the file handling action when the action is to be performed (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35)

30. Regarding Claim 65, Anderson in view of Shiohara discloses the computer-readable medium of claim 63 further including instructions for downloading all the executable files associated with the actions in the action list at the time the action list is downloaded (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35)

31. Regarding Claim 66, Anderson in view of Shiohara discloses the computer-readable medium of claim 61 wherein the at least one stored file comprises a digital image captured by the portable image capture device (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35)

32. Regarding Claim 67, Anderson in view of Shiohara discloses the computer-readable medium of claim 61 wherein the computer is used to access a server via a web browser, the computer-readable medium having further instructions for configuring the action list on the server in response to user input (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35)

33. Regarding Claim 68, Anderson in view of Shiohara discloses the computer-readable medium of claim 67 further comprising instructions for retrieving the user's account information, including the device type and an operating environment of the

device in response to the user logging into the server (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35)

34. Regarding Claim 69, Anderson in view of Shiohara discloses the computer-readable medium of claim 67 having further instructions for displaying to the user a list of supported user interface input events specific to the user's type of device for the user to select a desired set of input events (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35)

35. Regarding 70, Anderson in view of Shiohara discloses the computer-readable medium of claim 69 having further instructions for: displaying a set of available actions that can be performed when each selected event occurs; and providing an interface for the user to map one or more actions to each event (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

36. Regarding Claim 71, Anderson in view of Shiohara discloses the computer-readable medium of claim 70 wherein the set of available actions may include any combination of e-mailing the file as an attachment, posting the file to a photo sharing service, posting the file to a specified web site, resizing if the file is an image, and saving the file to a folder (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35)

37. Regarding Claim 72, Anderson in view of Shiohara discloses the computer-readable medium of claim 70 having further instructions for storing the mappings as a downloadable action list (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

38. Regarding Claim 73, Anderson in view of Shiohara discloses the computer-readable medium of claim 67 having further instructions for requesting the action list from the computer (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35)

39. Regarding Claim 74, Anderson in view of Shiohara discloses the computer-readable medium of claim 73 having further instructions for transmitting identity information from the device to the server for the server to use to retrieve the action list configured by the user and downloading the action list to the device (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

40. Regarding Claim 75, Anderson in view of Shiohara discloses the computer-readable medium of claim 67 having further instructions for downloading an executable file that is compatible with the device's operating environment (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

41. Regarding Claim 76, Anderson in view of Shiohara discloses the computer-readable medium of claim 61 having further instructions for: detecting the input events on the device; comparing the detected input events to the events listed in the



downloaded action list; and if a match occurs, performing the corresponding action or actions in the list by retrieving the executable file necessary to execute that action (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

42. Regarding Claim 77, Anderson in view of Shiohara discloses the computer-readable medium of claim 76 having further instructions for: determining if the executable file is present in memory of the portable image capture device; and if the executable file is present in the memory, retrieving and executing the executable file, thereby performing the action (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

43. Regarding Claim 78, Anderson in view of Shiohara discloses the computer-readable medium of claim 77 having further instructions for: if the executable is not present in the memory: requesting the executable file from the computer; and executing the executable file once received (Abstract, Figure 5, and Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SELAM T. GEBRIEL whose telephone number is (571)270-1652. The examiner can normally be reached on Monday-Thursday 7.30am-5.00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu NgocYen can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 2622  
Saturday, October 11, 2008

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